



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,262	02/24/2004	Yoichi Morimoto	FUJO 20.967	8916
26304 7590 03/14/2008 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585				
EXAMINER				
LEE, JUSTIN YE				
ART UNIT		PAPER NUMBER		
2617				
MAIL DATE		DELIVERY MODE		
03/14/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to amendment filed on 2/4/2008.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bach et al. (US 6,377,795) in view of McBride et al. (US 2002/01114431 A1) and further in view of Godbole (US 5,065,427).

Consider claims 9 and 11. Bach teaches a portable terminal device (Col 1 Line 63) and a method for preventing one-time only calls to a portable telephone set, comprising:

retrieving data from a telephone directory database if a call arrives at a portable terminal device, and determining whether an originating number is registered in the telephone directory database (Col 2 Lines 26-33); and

issuing one or more of the calling tone before connecting the call when the originating number is registered as a predetermined type of originator in the telephone

direction database (col. 2, lines 24-38, if the calling number matches with the pre-programmed number in the database the telephone will ring then connect).

Bach et al. do not disclose immediately connecting the call before the issuance of the calling tone if the originating number is not registered in the telephone directory database and announcing a prearranged recorded message.

McBride et al. further disclose immediately connecting the call before the issuance of the calling tone if the originating number is not registered in the telephone directory database (Fig. 10, steps 220, the call is connected and a prerecorded message is played (in step 217 or 246) before issuance of the calling tone (step 220)) and announcing a prearranged recorded message (Fig. 3 steps 115-119 and Fig. 10 steps 215-217 and 246 and paragraph 85 and 92, after a call is received, the caller ID is checked against a approved list. If the caller ID is not found in the approved list, a custom or canned greeting (prearranged recorded nonsensical message) is played to the caller. All these steps are done before the phone rings. The ring does not start until Fig. 10 step 220).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of McBride et al. into the teachings of Bach et al. and Walsh et al. for the purposes of providing a user to have full control of his/her phone calls to prevent unwanted calls (paragraph 19-22).

Bach et al. and McBride et al. do not disclose monitoring a calling time between the arrival of the call and an issuance of a calling tone.

Godbole further disclose monitoring a calling time between the arrival of the call and an issuance of a calling tone (Fig. 2A, after an incoming call is received, the time is monitored until an issuance of a calling tone).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Godbole into the teachings of Bach et al. and McBride et al. for the purposes of automatically processing an incoming call (col. 1, lines 38-45).

Consider claims 10 and 12. Bach et al. and McBride et al. further disclose if the originating number is registered in the telephone directory database, the telephone directory database is further retrieved, and if the originating number is for a call set to a zero-calling time, the call is immediately connected without a dial tone and a recorded message is announced to the originator. (Bach et al., col. 2, lines 26-33 and 43-46 and 54-58 and col. 6, lines 11).

4. Claims 1, 2, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bach et al. (US 6,377,795) in view of Callele (US 5,206,900) and further in view of McBride et al. (US 2002/01114431 A1) and Godbole (US 5,065,427).

With respect to claim 1, Bach et al. teaches a portable terminal device (Col 1 Line 63) and a method for preventing one-time only calls to a portable telephone set, comprising:

a determination unit retrieving data from a telephone directory database if a call arrives at a portable terminal device, and determining whether an originating number is registered in a telephone directory database (Col 2 Lines 26-33);

a transmitting unit immediately connecting the call (Col 2 Lines 43-46); and
the transmitting unit issuing one or more of the calling tone before connecting the call when the originating number is registered as a predetermined type of originator in the telephone directory database (col. 2, lines 24-38, if the calling number matches with the pre-programmed number in the database the telephone will ring then connect)

Bach et al. do not disclose a charge is imposed on an originator side when the call is connected.

Callele further discloses a charge is imposed on an originator side when the call is connected (col. 1, lines 13-15, the calling party is being charged when the called party directs the call to a recorded message).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Callele into the teachings of Bach et al. for the purposes of annoying the calling party (col. 1, lines 6-15).

Bach et al. and Callele do not disclose immediately connecting the call before the issuance of the calling tone if the originating number is not registered in the telephone directory database, and announcing a recorded message; and announcing a prearranged recorded nonsensical message.

McBride et al. further disclose immediately connecting the call before the issuance of the calling tone if the originating number is not registered in the telephone

directory database (Fig. 10, steps 220, the call is connected and a prerecorded message is played (in step 217 or 246) before issuance of the calling tone (step 220)) and announcing a prearranged recorded nonsensical message (Fig. 3 steps 115-119 and Fig. 10 steps 215-217 and 246 and paragraph 85 and 92, after a call is received, the caller ID is checked against a approved list. If the caller ID is not found in the approved list, a custom or canned greeting (prearranged recorded nonsensical message) is played to the caller. All these steps are done before the phone rings. The ring does not start until Fig. 10 step 220).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of McBride et al. into the teachings of Bach et al. and Callele for the purposes of providing a user to have full control of his/her phone calls to prevent unwanted calls (paragraph 19-22).

Bach et al. and Callele and McBride et al. do not disclose a calling time monitoring unit monitoring a calling time between the arrival of the call and an issuance of a calling tone.

Godbole further disclose a calling time monitoring unit monitoring a calling time between the arrival of the call and an issuance of a calling tone (Fig. 2A, after an incoming call is received, the time is monitored until an issuance of a calling tone).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Godbole into the teachings of Bach et al. and Callele and McBride et al. for the purposes of automatically processing an incoming call (col. 1, lines 38-45).

Consider claim 2. Bach et al. and Callele and McBride et al. and Godbole together further disclose wherein if the originating number is registered in the telephone directory database, the telephone directory database is further retrieved, and if the originating number is for a call set to a zero-calling time, the call is immediately connected without a dial tone so that a charge is imposed on an originator side and a recorded message is announced to the originator (Bach et al., col. 1, lines 63, col. 2, lines 26-33, Col 2 Lines 43-46, Col 6 Line 11, Col 2 Lines 54-58 and Callele, col. 1, lines 13-15).

With respect to claim 5, Bach et al. and Callele and McBride et al. and Godbole together further disclose the portable terminal device according to claims 1 & 2, wherein after the recorded message is announced to the originator, a message from the originator is recorded (Bach et al., Col 2 Line 65-Col 3 Line 11).

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bach et al. (US 6,377,795) in view of Callele (US 5,206,900) and further in view of McBride et al. (US 2002/01114431 A1) and Godbole (US 5,065,427) as applied to claim 1 and further in view of Cannon et al. (U.S. 6,026,152).

Bach et al. and Callele and McBride et al. and Godbole together disclose the portable terminal device according to claim 1. Bach et al. and Callele and McBride et al. and Godbole fails to expressly disclose the zero-calling time setting is made in a recorded message response time area of the telephone directory database.

In the same field of endeavor, Cannon teaches a similar device wherein the zero-calling time setting is made in a recorded message response time area of the telephone directory database (Col 2 Lines 35-41; Col 3 Lines 49-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the zero-calling time setting in a recorded message response time area of the telephone directory database, so the setting can be directly associated with the different numbers in the database.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Y. Lee whose telephone number is (571) 272-5258. The examiner can normally be reached on M - Thu 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Justin Lee
AU 2617
3/4/08

/DUC NGUYEN/
Supervisory Patent Examiner, Art Unit 2617

Office Action Summary

Application No.

10/785,262

Applicant(s)

MORIMOTO, YOICHI

Examiner

Justin Y. Lee

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____